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Dated: August 29, 2008

Signature: /Lynn L. Janulis/ 53,066  
(Lynn L. Janulis)

Docket No.: 29636/39363A  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Jessberger et al.

Confirmation No.: 8165

Application No.: 10/570,047

Filed: February 28, 2006

Art Unit: 1635

For: Methods for Identifying, Treating, and Inducing  
Infertility Using SMC1-Beta

Examiner: Dana Shin

**RESPONSE TO RESTRICTION REQUIREMENT**

MS Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to the restriction requirement set forth in the Office Action mailed February 29, 2008, Applicants hereby provisionally elect Group I (claims 1-2, 10-19, 29-32, 34-44, 48-49, and 134), with traverse.

Applicants request that the restriction requirement be reconsidered because the Examiner has not shown that a serious burden would be required to examine all of the claims and at least the claims in Groups I-IV. M.P.E.P. § 803 provides:

If the search and examination of an application can be made without serious burden, the Examiner **must** examine it on the merits, even though it includes claims to distinct or independent inventions. (*Emphasis added.*)

Thus, for a restriction to be proper, the examiner must satisfy the following two criteria: (1) that independent and distinct inventions are being claimed (35 U.S.C. § 121); and (2) that the search and examination of the entire application cannot be made without serious burden. See M.P.E.P. § 803.

The Examiner has not shown that it would be a serious burden to search and examine Groups I-IV together. Groups I-IV are all drawn to methods of inducing infertility in an animal comprising inhibiting SMC1 $\beta$  expression or activity in said animal.

It is probable that a search based on agents that inhibit SMC1 $\beta$  expression or activity will identify similar or the same art. Although the agents may not share a common structure, the agents act to inhibit polynucleotide or polypeptide expression. Existing search engines permit a searcher to search translations of the polynucleotide sequences of SMC1 $\beta$  and permit rapid comparisons of polynucleotide and polypeptide databases. Thus, the search should uncover art relevant to all agents that inhibit SMC1 $\beta$  polynucleotide and polypeptide expression, including antisense oligonucleotides, small molecule antagonists, peptidomimetic antagonists, and antibodies. Accordingly, because there would be no serious burden on the Examiner to search and examine Groups I-IV together, these groups should be examined simultaneously. In view of the foregoing, Applicants respectfully request that all claims in Groups I-IV be examined.

Applicants reserve the right to rejoinder of non-elected claims that depend from or otherwise require all the limitations of an allowable claim. See M.P.E.P. § 821.04. This response is timely filed along with a petition for an extension of time and the requisite fee.

Dated: August 29, 2008

Respectfully submitted,

By /Lynn L. Janulis/

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